

REMARKS/ARGUMENTS

Claims 1 – 21 are in the application. Claims 13, 14, 17 and 18 have been withdrawn. Reconsideration is respectfully requested.

Claim Rejections Under 35 USC § 101.

Claims 1 – 12, 15 and 16 were rejected under Section 101 as failing to disclose a tangible result. The rejection grounds specifically stating that “*There is no tangible result in returning a probability.*”

In reply, applicant first wishes to clarify that the noun “probability” is a common term of art quantifying the likelihood that something exists or is likely to happen. Oftentimes, probabilities may be stated in terms of percentages. Applicant further notes that, as clarified in amended claim 1, the item returned is a probability of the locality name submitted by the user being associated with a geographical location.

For example, if a user submits as criteria the locality name “Paris,” the method described might return a 90% (or 0.90) probability that the “Paris” locality name submitted by the user is associated with a particular geographical location, such as France or Texas. One can appreciate that the value of the returned probability or quantity is a tangible result in that it can be used, for example, to select for further processing or display information carrying the highest probabilities.

In this regard, applicant believes that it is fair to compare the returned probability (such as a particular percentage) with the share price (a specific quantity) that was returned in the system claimed in the important case of State Street Bank¹ where the Court of Appeals for the Federal Circuit stated:

"[T]he transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation,

¹ *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998)

because it produces 'a useful, concrete and tangible result' - a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." (See MPEP §2106, Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility)

Accordingly, applicant submits that claims 1 – 12, 15, and 19 - 21 meet the requirements of 35 USC § 101. Similarly, claim 16, which includes a refining step that indicates a probability (that the user is located in a sub-location) also recites a tangible result, as explained above in connection with claim 1. Accordingly, claim 16 passes muster under 35 USC § 101.

Claim Rejections Under 35 USC § 112

The “indefinite” rejection grounds state that as respects claim 1, *“the applicant recites ‘returning, in dependence on the locality name, a probability.’ Claim 1 appears to be incomplete and has missing steps. Applicant recites entering ‘locality name.’ If the information is entered, why is it returned?”*

In reply applicant refers to the clarifying amendments and remarks made in the previous section of this amendment. Put another way, a *locality name* is entered in the present invention and a *probability*² is returned. The probability which is returned is dependent upon the locality name that is originally submitted by the user. Without the locality name, the probability cannot be determined. One set of information is entered into the system and a different set is returned.

Applicant believes that the foregoing explanation will permit the Examiner to withdraw the rejection under 35 USC § 112.

Claim Rejections Under 35 USC § 102

The Examiner has averred that the present invention is not novel over the disclosure of US Patent No. 6,249,252 (Dupray). In forming the rejection grounds against claim 1, the Examiner refers to column 21 and column 27 of Dupray. It appears, however, that the Examiner may have failed to acknowledge that there are references in Dupray to determining the location of a mobile

² That is, the probability of the locality name being associated with a geographical location.

base station (MBS), and to a mobile station (MS). The teachings regarding these two features should not be confused when construing Dupray.

It is clear from reading Dupray that the user referred to in the present application is generally comparable to the user of the mobile station (MS) in Dupray because this is the user who requires further information.

The user of the mobile station in Dupray does not, however, “submit criteria including a locality name” as required by claim 1. Instead, measurements are taken based upon signals transmitted by the mobile station to various base stations (both fixed and mobile). The mobile station is seeking its current geographical location and, hence, does not transmit a locality name to any of the base stations during this process because the mobile station is unaware of its location at this stage. The signals transmitted by the mobile station to the base stations are generally the normal signals which you would expect to find transmitted during, for example, hand shaking operations between the mobile station and the base stations. This is exemplified in Dupray by the use of CDMA pilot channels.

Dupray does state that the location of a mobile base station (MBS) may be manually entered by an operator of the mobile base station. In Dupray, it is stated that it is necessary to determine the location of the mobile base station in order that the relative location of the mobile station can be accurately determined. The operator of the mobile base station has no desire to obtain further information based upon his current likely geographical location. Indeed, the operator of the mobile base station must know his current location in order to enter the information into the mobile base station unit. Therefore, the operator of the mobile base station is not “a user” as recited by claim 1 of the present application.

Moreover, Dupray does not disclose the recited step of “identifying from the criteria the locality name.” In particular, the mobile station does not transmit a locality name to any of the other components in the system disclosed in Dupray and, therefore, identification from the criteria of the locality name cannot occur.

In relation to the mobile base station, the user of the mobile base station only submits the locality name in isolation. Other information which may be transmitted by the mobile base station occurs automatically and is not submitted by the user.

Thus, there is no need to identify from the criteria the locality name when considering the mobile base station.

Finally, Dupray does not disclose the step of “returning, ... in dependence on the locality name, a probability of the locality name being associated with a geographical location.” In particular, in the case of the mobile station, no locality name has been submitted and, hence, a probability that an un-submitted locality name is associated with a geographical location cannot be determined. Dupray does, however, disclose the calculation of probabilities that a geographical location identified by the signals received by the various base stations is an accurate geographical location. However, since no locality name is submitted by the user of the mobile station in the first instance, no probability can be determined in dependence on the non-existent locality name.

In relation to the mobile base station, Dupray states that any manually entered locality name should be considered the most accurate form of geographical location. As such, although a probability may be associated with the manually entered locality name, that probability will always be “1”. Indeed, it is clear that the probability is not “in dependence on the locality name” but is rather dependent upon the existence of a locality name. In other words, any information entered as a locality name into the system will be given the same probability. The probability given is not dependent upon the information which is actually entered but rather simply on the fact that information has been entered.

With regard to claim 16, many of the arguments presented above also apply in relation to this claim.

In addition, the Examiner has made reference to figure 6(3) of Dupray. This figure shows the location signature database described in Dupray. The location signature database stores signatures of signals which are unique or substantially unique to the location concerned. The information is independent of the mobile station in question and may be used in relation to all mobile stations operating within the system. In contrast, the present invention, as recited by claim 16, requires “*holding ... geographical location information mapped from a user’s computer network address.*” Therefore, any geographical location information which is held must be mapped to the user’s specific computer network address. This step of the present invention is not comparable with the location signature database shown in figure 6(3) of Dupray.

Moreover, the location signature database of Dupray (which the Examiner states is comparable to the geographical location information mapped to the user's network address) is not refined to indicate a probability that the user is located in a sub-location within the geographical area. As stated above, the location signature database is independent of the specific mobile station to which the stored data is being applied. The location signature database disclosed in Dupray is never updated with a specific user's information. Instead, the database is only updated with verified information regarding the location in which, for example, certain CDMA signal characteristics always occur.

In view of the foregoing, Dupray fails to anticipate, expressly or inherently, the inventions described in the claims as amended.

New claims 19 – 21 are added here. These claims should be allowable as depending from a now-allowable base claim 1. Moreover, although Dupray discusses an operator of a mobile base station submitting a locality name as text, the system does not teach or suggest dividing the text into text that is a locality name and text that is not a locality name since all of the text in Dupray is a locality name.

Moreover, in Dupray no content is provided to the operator of the mobile base station based upon any returned probabilities. It is the user of the mobile station who is requesting content and not the user of the mobile base station and the user of the mobile station does not enter any text.

Conclusion

In view of the foregoing, applicant believes that all of the currently pending claims are in condition for allowance, and an early notification to that effect is respectfully requested. If the Examiner has any questions, she is invited to contact applicant's attorney at the below-listed telephone number.

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